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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/089,815	07/01/2002	Jonathan Sharp	367.41537X00	5578
20457	7590	09/12/2005	EXAMINER	
ANTONELLI, TERRY, STOUT & KRAUS, LLP 1300 NORTH SEVENTEENTH STREET SUITE 1800 ARLINGTON, VA 22209-3873			PHU, SANH D	
			ART UNIT	PAPER NUMBER
			2682	

DATE MAILED: 09/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/089,815

Applicant(s)

SHARP, JONATHAN

Examiner

Sanh D. Phu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action is responsive to the Amendment filed on 7/8/05.

Claim Rejections – 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35

U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 14–15, 20–24, 29, 31–33 and 37–40 are rejected under 35

U.S.C. 102(e) as being anticipated by Mottier et al (5,542,103), previously cited.

–Regarding to claim 14, see Fig. 1, 2 and col. 2 lines 11 to 56, Mottier et al disclose a portable device (see Fig. 2) comprising:

a user input (volume key and 204) comprising a key (volume key) having a first function (101, 102, 105, 109) of performing a shortcut to a

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predetermined menu (MENU) when the device is in a first state (standby while monitoring for an incoming call) and a second function (109, 110, 111, 112) of selecting menu and/or activating feature(s) when the device is not in the first state;

a processor (203) (see figure 2) which determines the state of the device and performs a function in response to a first mode (105) of operation of the key (see Fig. 1); and

wherein the second function is a change of state of the device to the first state (see feedbacks from (112) to (101,102) of Fig. 1), and the predetermined menu comprises a list of first level menu items (features) (see col. 2, lines 43–46).

–Regarding to claim 15, Mottier et al disclose a device wherein the first state is an idle state (101) (see Fig. 1).

–Regarding to claim 20, Mottier et al disclose a device wherein the first level menu items include at least one item of call divert, settings (e.g., auto answer DTMF input, auto-answer voice record, auto-answer voice outgoing only, (see col. 2, lines 43–46).

–Regarding to claim 21, Mottier et al disclose a device wherein the predetermined menu (109) comprises a second level menu (a different feature) when the volume key is pressed an additional time (see col. 2, lines 50–52).

–Regarding to claim 22, claim 22 is rejected with the similar reason as set forth in the claim 21.

–Regarding to claim 23, Mottier et al disclose a device wherein the key has a third function (112) when the volume key is pressed an additional time (see (110) of figure 1 and col. 2, lines 47–56) and the processor performs the third function (112) in response to a second mode (110, 111) of operation of the key (see Fig. 1).

–Regarding to claim 24, Mottier et al disclose a device wherein the third function is associated with a second state of the device (when the volume key is pressed an additional time (see (110) of figure 1 and col. 2, lines 47–56); the key has a fourth function associated with a third state of the device (when the volume key is pressed more than one additional times (see (110) of figure 1 and col. 2, lines 47–56); and

the processor performs third or fourth functions (112) in response to

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the second mode of operation of the key, depending upon a state of the device (see Fig. 1 and col. 2, lines 47–56).

–Regarding to claim 29, Mottier et al disclose a device wherein the key is a button (volume key) (see Fig. 2).

–Regarding to claim 31, Mottier et al disclose a device is a radiotelephone (see Fig. 2).

–Regarding to claim 32, claim 32 is rejected with the similar reasons as set forth in claim 23.

–Regarding to claim 33, claim 33 is rejected with the similar reason as set forth in the claims 23 and 32.

–Regarding to claim 37, as applied to claim 14, see Fig. 1, 2 and col. 2 lines 11 to 56, Mottier et al discloses a method comprising:

step (using a volume key) of actuating a user input comprising a key (the volume key) having a first function (101, 102, 105, 109) of performing a short cut to a predetermined menu (MENU) when the device is in a first state (standby while monitoring an incoming call), actuating the user input when the device is

not in the first state, the key having a second function (109, 110, 11, 112) of selecting and/or activating feature(s) when the device is not in the second state;

one of the first function and the second function being performed in response to a first mode of operation of the key and upon determining the state of the device (e.g., the first function is performed in response to a mode, in which the volume key is pressed twice (see (105) of figure 1); and upon determining the state indicating that an incoming has been received).

wherein the second function of the user input is a change of state of the device to the first state (see feedbacks from (112) to (101, 102) of figure 1), and the predetermined menu comprises a list of first level menu items (features) (see col. 2, lines 43–46).

–Regarding to claim 38, as applied to claim 14, see Fig. 1, 2 and col. 2 lines 11 to 56, Mottier et al discloses a computer program (inherently included as being installed in a programmable processor (MICROCOMPUTER WITH MEMORY (203)) (see figure 2) wherein the computer program comprises program instructions for operation of a portable device (figure 2) and when

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loaded onto the processor MICROCOMPUTER WITH MEMORY, causing the processor to perform:

step (203) of detecting actuation of a user input comprising a key (volume key) having a first function (101, 102, 105, 109) of performing a shortcut to a predetermined menu (MENU) when the device is in a first state (standby while monitoring an incoming call), and a second function (109, 110, 111, 112) when the device is not in the first state;

step (203) of determining the state of the device whether or not it is in the first state (see (102) of figure 1);

step (203) of selecting one of the first function and the second function in accordance with the determining state of the device; and

step (203) of performing the selected function in response to a first mode of operation of the key, (e.g., the first function is performed in response to a mode, in which the volume key is pressed twice (see (105) of figure 1); and upon determining the state indicating that an incoming has been received); and wherein

the second function of the user input is a change of state of the device to the first state, (see feedbacks from (112) to (101, 102) of figure 1), and the predetermined menu comprises a list of first level menu items (features) (see col. 2, lines 43–46).

–Regarding to claim 39, Mottier et al discloses a physical entity (figure 2) embodying the computer program.

–Regarding to claim 40, Mottier et al discloses an electromagnetic carrier signal carrying out the computer program (e.g., the computer program detects an incoming call based up on the incoming call (which is inherently an electromagnetic carrier signal being received from a base station (see col. 2, lines 11–30).

Claim Rejections – 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 25–28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mottier et al (5,542,103) in view of Mitchell et al (5,966,671), previously cited.

–Regarding to claim 25, Mottier et al does not specifically disclose the processor determines the mode of operation of the key by duration of operation.

Mitchell et al disclose a device wherein the processor determines the mode of operation of the key by duration of operation (see Fig. 6, col. 4, line 38).

It would have been obvious for one skilled in the art to implement Mottier et al 's application, as taught by Mitchell et al, in order to make a multifunctional key so that the device is more compact.

–Regarding to claim 26, claim 26 is rejected with the similar reason as set forth in the claim 25.

–Regarding to claim 27, Mottier et al does not specifically disclose a device wherein the first mode of operation has duration less than a predetermined threshold.

Mitchell et al disclose a device wherein the processor determines the mode of operation of the key by duration of operation and less than a predetermined threshold (750ms)(see Fig. 6, col. 4, lines 34–62).

It would have been obvious for one skilled in the art to implement Mottier et al 's application with 750 ms threshold, as taught by Mitchell et al, in order to have a distinguishes between long and short press of the key button so that the user is able to avoid inadvertent presses.

–Regarding to claim 28, claim 28 is rejected with the similar reason as set forth in the claim 27.

6. Claims 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mottier et al (5,542,103).

–Regarding to claim 30, Mottier et al does not specially disclose the key (volume key) is to turn off the device. However, the examiner takes official Notice that a multifunctional key is well known in the art. Therefore, it would

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have been obvious for one skilled in the art at the time of the invention was made to have the multifunctional key in Mottier et al, so that the device is more compact.

Response to Arguments

7. Applicant's arguments filed on 7/8/05, with respect to claims 14, 15, 20-40, have been fully considered; however, the claims, after being amended or newly added, are deemed not overcome the previously-cited references with the reasons stated in the corresponding rejections to the claims, set forth above in this Office Action.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on


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the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sanh D Phu whose telephone number is (703) 305-8635. The examiner can normally be reached on 8:00-16:30.

The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-8635.


NICK CORSARO
PRIMARY EXAMINER

Sanh D. Phu
Examiner
Art Unit 2682

SP